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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,184	03/14/2001	Kenji Ohshima	Q63509	2848

7590 05/15/2003  
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Washington, DC 20037-3202

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

8

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/805,184	OHSHIMA ET AL.	
	Examiner	Art Unit	
	Christopher P Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 7-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

2. Applicant's election without traverse of Group I Claims 1-6 in Paper No. 7 is acknowledged.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. 112 rejections of claims 1-6 of record in Paper #5, Page 4 Paragraph 5 have been withdrawn due to Applicant's amendment in Paper #7.

***REJECTIONS REPEATED***

4. The 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Nedstedt is repeated for the reasons previously of record in Paper #5, Page 5 Paragraph 6.

5. The 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Lammers is repeated for the reasons previously of record in Paper #5, Pages 5-6 Paragraph 7.

6. The 35 U.S.C. 103 rejections of claims 1-6 over Nedstedt in view of Adams et al is repeated for the reasons previously of record in Paper #5, Pages 7-8 Paragraph 8.

#### ***NEW REJECTIONS***

##### ***Claim Objections***

7. Claim 1 is objected to because of the following informalities: on line 2 there is a comma and semicolon separating "therein" and "and"; also it is suggested that the phrase "for providing information as to the type of said sheet roll cartridge" be changed to "for providing information to identify different said sheet roll cartridges" in order to provide better clarification within the claim language. Appropriate correction is required.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 112 rejections of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Nedstedt have been fully considered but they are not persuasive.

In response to Applicant's argument that Nedstedt does not have a target that is detectable for providing information as to the type of the sheet roll cartridge, the field-generating element of Nedstedt is a target that is detectable within the roll core. The field-generating element is detectable for providing information as to the type of the sheet roll, specifically whether the sheet roll is a full sheet roll or an empty sheet roll. Further, the limitation only requires that the target or element within the core be able to be used in this process of determining the type of sheet roll. Structurally the field-generating element of Nedstedt is a target that is detectable and therefore anticipates the target of the instant invention. Note also that although Nedstedt fails to teach the explicit function of the target that applicant is claiming it would be within the realm of one having ordinary skill in the art to use the same target taught by Nedstedt for determining whether the sheet roll was full or empty for the purpose of determining the identification of the sheet roll.

10. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Lammers have been fully considered but they are not persuasive.

In response to Applicant's argument that Lammers does not have a target that is detectable for providing information as to the type of the sheet roll cartridge, the signal-generating element of Lammers is a target that is detectable within the roll core. The signal-generating element is detectable for providing information as to the type of the sheet roll. The limitation only requires that the target or element within the core be able to be used in this process of determining the type of sheet roll. Also, note that the intended use of the target in an article claim is not given patentable weight, therefore claim 1 requires a sheet rolled in a tubular manner containing a target disposed in the hollow portion that is detectable and can be used for providing information as to the type of said sheet roll cartridge. Structurally the signal-generating element of Lammers is a target that is detectable and therefore anticipates the target of the instant invention.

11. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 103 rejections of claims 1-6 over Nedstedt in view of

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Adams et al have been fully considered but they are not persuasive.

In response to Applicant's argument that Adams et al is directed to non-analogous art, a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering this problem. This is specifically true when the inventions are similar in structure and function. Both a bobbin for yarn and a core for a sheet roll are structurally similar as tube for wrapping a sheet around it and functionally they are both used to roll and unroll sheets of material. Also, it has been held that in a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist. One of ordinary skill in the art would have recognized that bobbins would have the same problem of determining what type of material is wrapped around the bobbin.

In response to the applicant's argument that the Nedstedt device and the Adams device are not combinable, the signal-generating element of Nedstedt is a necessary portion of the invention and must be found in the invention, however an insert

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of a colored target could also be added to the Nedstedt device so that the sheet material on that device is distinguishable from other similar devices with different sheet material, as taught by Adams et al. Further, the concept of adding a color target to the roll taught by Adams for distinguishing types of sheet roll is also accomplished by coloring the signal-generating element or target of Nedstedt.

In response to the applicant's argument that none of the art teaches or suggest a target located at one of a plurality of predetermined positions, the target of Nedstedt is located at the center of the core which is a predetermined position and the target of Adams is positioned at the end of a core which is a predetermined position. The intended use of the target of positioning for determination of the type of sheet roll receives little patentable weight because structurally when a target is provided in the center it is positioned where the type of sheet roll could be determined, and articles are only defined by their structure not merely stating an intended use.

### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes

Examiner

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CPB

May 13, 2003

*Chris Bruenjes*

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*5/13/03*